

REMARKS

Reconsideration and withdrawal of the requirement for election of species are respectfully requested in view of the remarks herewith, which place the application into condition for allowance. }

Although it is believed that no fee is required for consideration of this paper, if a fee is due, then the Assistant Commissioner is authorized to charge such fee, or credit any overpayment, to Deposit Account 50-0320.

Applicants respectfully traverse the requirement if the Examiner treats the Requirement as a Restriction Requirement and does not continue to examine additional species should the Examiner find the newly elected species allowable.

It is Applicant's understanding that upon allowance of a generic claim, Applicants will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitation of an allowed generic claim as provided by 37 C.F.R. 1.141.

Applicants respectfully traverse this Requirement for an Election of Species since the species, while distinct, are related to one another and directed to the same inventive concept which may be simultaneously searched. Specifically, all compounds of the present invention are herbicidally active benzoylcyclohexanediones which share similar function and exhibit structurally similar substitutions in the 3-position of the phenyl ring.

Applicants urge that the Requirement is improper as it does not demonstrate that searching all the inventions constitute an undue burden to the Office and because it is contrary to public policy. The MPEP lists two criteria for a proper Restriction Requirement. First, the invention must be independent or distinct. MPEP § 803. Second, searching the additional invention must constitute an undue burden on the examiner if restriction is not required. *Id.* The MPEP directs the examiner to search and examine an entire application "[i]f the search and examination of an entire application can be made without serious burden, ... even though it

includes claims to distinct or independent inventions.” *Id.* Since the Requirement does not indicate that searching would constitute an undue burden, this requirement is not met.

Further, it is respectfully urged that restricting the claims in the manner suggested in the Requirement constitutes an undue burden to Applicants as well as the public and, thus, is against public policy. If followed, the Requirement would require Applicants to file an indeterminable number of patent applications. In addition, under GATT, the period of exclusivity for any patents, which issue from the divisional application, is greatly reduced. Applicants cannot mitigate against this because the Requirement does not identify the number of inventions present. Similarly, the public is inconvenienced, as they will not know whether or not Applicants will file divisional applications to the remaining subject matter. Accordingly, the public will not know if they can practice the remaining invention without infringing future patent applications.

In view of the foregoing, the claims of the present application represent a web of knowledge and continuity of effort that merits examination in a single application. Accordingly, modification or withdrawal of the Species Election Requirement are requested, and an early action on the merits is earnestly solicited.

Accordingly, in view of the foregoing, reconsideration and modification of this Restriction Requirement is requested and an early action on the merits is earnestly solicited

Respectfully submitted,
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